The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARSHISH CYRUS KAPADIA and JOSEPH LOYD SELF

Appeal No. 2005-1622
Application 09/333,894

ON BRIEF

Before THOMAS, HAIRSTON, and LEVY, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 4 and 6 through 43.

The disclosed invention relates to a method and system that provide for a default selection during a configuration session in which a product is configured by a user.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method for configuring a product, comprising:

initiating a configuration session in which a user configures a product comprising a configuration of items selected from a plurality of items;

generating a series of selection option sets, each selection option set comprising one or more items;

during the configuration session, for each of the series of selection option sets, receiving data from an available to promise engine regarding the one or more items in the selection option set;

during the configuration session, for each of the series of selection option sets, dynamically applying an optimization function with respect to each item in the selection option set according to the data received from the available to promise engine during the configuration session to identify an item of the selection option set as a default selection, the default selection being optimal among the one or more items of the selection option set with respect to the dynamically applied optimization function;

providing for presentation to the user the series of selection option sets, each selection option set comprising its identified default selection;

accepting from the user a selection of an item for each of the series of selection option sets; and

determining a configuration for the product in accordance with the selections of the items from the series of selection option sets.

The references relied on by the examiner are:

Henson 6,167,383 Dec. 26, 2000
(filed Sept. 22, 1998)
Rhythm Systems, i2 Technologies, Inc., 1998.

Claims 1 through 4 and 6 through 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson in view of the Rhythm publication.

Reference is made to the briefs and the answer for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the obviousness rejection of claims 1 through 4 and 6 through 43.

Based upon the examiner's rejection (answer, page 4), it appears that Henson was cited by the examiner merely because it discloses a configurator[1]. The Rhythm publication was cited by the examiner because it teaches "an order promise solution that allows the sales organization to have global visibility and allows large-scale ERP [Enterprise Resource Planning] order management systems to provide accurate quotes in real time," and because it "allows companies to model and implement their business rules using a wide range of constraint to achieve optimization" (answer, page 4). Based upon the teachings of the references, the examiner concluded (answer, page 4) that "[i]t would be obvious to a person of ordinary skill in the art to

[1] The appellants acknowledge (specification, pages 3 and 4) that a configurator (i.e., a configuration engine) is well known in the art as evidenced by the Rhythm publication.

include in Henson the optimization capabilities offered by Rhythm, because this would increase the likelihood of promised delivery dates being met and increase customer satisfaction."

Appellants argue inter alia (brief, page 9) that:

> As made clear in Appellants' claims and during prosecution, it is not any particular optimization functions that Appellants seek to patent, but instead the dynamic application of an optimization function, with respect to each item in each of a series of selection options sets during a product configuration session, according to data received from an available-to-promise engine during the product configuration session, to identify an item of each selection option set as a default selection that is optimal among the one or more items of the selection option set with respect to the dynamically applied optimization function.

Appellants additionally argue (brief, pages 9 and 10) that the combined teachings of the references do not provide any "disclosure, teaching or suggestion" of the limitations of the claimed invention.

We agree with appellants' arguments. We agree with the examiner's finding (answer, page 4) that the only relevance Henson has to the claimed invention is that it discloses a configurator. Although optimization is indeed a goal in the Rhythm publication, we agree with the appellants that an optimization function is not used in the Rhythm publication to identify during a configuration session a "default" selection of

an item as required by all of the claims on appeal. Thus, the obviousness rejection of claims 1 through 4 and 6 through 43 is reversed.

DECISION

The decision of the examiner rejecting claims 1 through 4 and 6 through 43 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
)
)
) BOARD OF PATENT
KENNETH W. HAIRSTON) APPEALS AND
Administrative Patent Judge) INTERFERENCES
)
)
)
STUART S. LEVY)
Administrative Patent Judge)

KWH:pgc

Appeal No. 2005-1622
Application 09/333,894

Christopher W. Kennerly, Esq.
Baker Botts L.L.P.
2001 Ross Avenue
Suite 600
Dallas, TX 75201-2980